

REMARKS

In the Office Action¹ the Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,963,925 to Kolling ("*Kolling*") in view of U.S. Patent No. 7,028,008 to Powar ("*Powar*").

By this amendment, Applicant cancels claims 1-23 and adds new claims 31-53. New claims 31-53 generally correspond to cancelled claims 1-23 and present the subject matter of the cancelled claims in better form. Support for the amendments can be found in the claims as originally filed and in the specification at, for example, page 19 lines 13-15. Claims 31-53 are pending.

Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 1, insofar as it may be considered to apply to new claim 31, under 35 U.S.C. § 103 as being obvious from *Kolling* in view of *Powar*. A *prima facie* case of obviousness has not been established, at least with respect to the newly added claim.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . .

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

[R]ejections on obviousness cannot be sustained with mere conclusory statements.” *M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008)*(internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” *M.P.E.P. § 2141(II)*. In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P. § 2141(III)*. Here, no *prima facie* case of obviousness has been established for at least the reason that the scope and content of the prior art have not been properly determined nor have the differences between the claimed invention and the prior art been properly ascertained.

Independent claim 31 calls for a combination including, for example:

extracting billing information from the electronic image information using a predefined template corresponding to the identified bill type, wherein the predefined template includes zone information for locating portions of the billing information;

The cited art, alone or in combination, fails to disclose or suggest at least this element of claim 31.

On page 4 of the Office Action, the Office Action correctly concedes that “[*Kolling*] does not specifically teach receiving paper bills for conversion to electronic bills.” However, the Office Action alleges that *Powar* discloses these claimed features and, more particularly, “wherein the billing information is extracted using a predefined

template for the type of bill identified" in column 5, line 50 to column 6, line 17. This is incorrect.

Power discloses a "Method and Apparatus for Paying Bills Electronically Using Machine Readable Information from an Invoice" (title). *Power* further discloses, in column 2, lines 60-65:

[the] machine readable information [is] in a **standardized format** [...] and the information is readable at the consumer end **without prior arrangements being made specifically between the consumer and the biller** (emphasis added)

In fact, *Power* specifically teaches that the "data to be captured by consumer C" is to be included in the "**universal encoding region 304**" (column 4, lines 51-54 of *Power*, emphasis added), as opposed to "using a predefined template corresponding to the identified bill type, wherein the predefined template includes zone information for locating portions of the billing information." The universal encoding region 304 is shown as a standardized bar code in Figure 3 of *Power*. Moreover, in column 3, lines 1-7, *Power* lists the ways the machine readable data "can be read from a biller's invoice":

the biller could print the information using **optically-readable an [sic] barcode**, using a font designed for error-free optical character recognition, or using **magnetically-readable characters (MICR)**. Alternatively, a **magnetic strip** could be provided on the invoice. (emphasis added)

Each of these reading techniques requires that the data be in a "standardized format" with "universal encoding," as explicitly taught by *Power*, rather "using a predefined template corresponding to the identified bill type." Although the Office Action cites columns 5 and 6 of *Power* as providing identifying a type of bill and a corresponding

format, in fact no bill type nor template is mentioned in any portion of *Power*. Rather, column 5 lines 50-52 of *Power* explicitly teach that:

The first step (step S1) is for biller B to send consumer C a bill encoded with the **universal encoding**. **Because it is a universal encoding, any consumer can read, capture and validate it without prior contact or arrangement with biller B.** (emphasis added)

Therefore, *Power* fails to teach, disclose or suggest at least:

extracting billing information from the electronic image information using a predefined template corresponding to the identified bill type, wherein the predefined template includes zone information for locating portions of the billing information;

as recited in new claim 31.

The Office Action alleges that *Kolling* teaches "a plurality of templates" in column 10. However, *Kolling* specifically teaches in column 9, lines 55-57 that:

A template contains the programmed instructions and graphic pattern for statement information **to be presented to the consumer** (emphasis added)

Therefore, neither the cited portion of *Kolling*, nor any other portion of *Kolling*, teaches at least a "predefined template [that] includes zone information for locating portions of the billing information" on a paper bill, as claimed in claim 31.

In view of the deficiencies of the prior art set forth above, the Office has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Moreover, the Office Action has provided insufficient motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed

combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of claim 1 under 35 U.S.C. §103 as being obvious from *Kolling* in view of *Powar*, insofar as it may apply to newly added claim 31, is thus improper and should be withdrawn. The rejections under 35 U.S.C. §103 of claims 9, 13 and 16, insofar as they apply to newly added independent claims 39, 43 and 46 should be withdrawn for at least the reasons given above with respect to claim 31 since claims 39, 43 and 46 recite similar elements as above.

Moreover, rejections under 35 U.S.C. §103 of claims depending or ultimately depending from independent claims 31, 39, 43 and 46 are improper and should be withdrawn for at least reasons given above with respect to the independent claims.

Applicant respectfully traverses the rejection of dependent claims 2-8, 10-12, 14, 15 and 17-23 under 35 U.S.C. § 103(a) as being unpatentable over *Kolling* in view of *Powar* insofar as they apply to newly added claims 32-38, 40-42, 44, 45 and 47-53. A *prima facie* case of obviousness has not been established.

Claims 32-38 depend or ultimately depend from claim 31 and thus include all the elements thereof. Claims 40-42 depend or ultimately depend from claim 39 and thus include all the elements thereof. Claims 44 and 45 depend or ultimately depend from claim 43 and thus include all the elements thereof. Claims 47-53 depend or ultimately depend from claim 46 and thus include all the elements thereof. As set forth above, neither *Kolling* nor *Powar* teach or suggest at least:

extracting billing information from the electronic image information using a predefined template corresponding to the identified bill type, wherein the predefined template includes zone information for locating portions of the billing information;

as recited in claim 31 and similarly recited in claims 39, 43 and 46 and, therefore, included in claims 32-38, 40-42, 44, 45 and 47-51.

Therefore, the Office has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Moreover, the Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no prima facie case of obviousness has been established. The rejections of dependent claims 2-8, 10-12, 14, 15 and 17-23 under 35 U.S.C. § 103(a) as being unpatentable over *Kolling* in view of *Power*, insofar as they apply to newly added claims 32-38, 40-42, 44, 45 and 47-53, are thus improper and should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Robert E. Converse, Jr.
Reg. No. 27,432
(202) 408-4000